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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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LM02/1002

EXAMINER

PSITOS, A

ART UNIT

PAPER NUMBER

2752

DATE MAILED:

10/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/406,570

Applicant(s)

Shimizu et al

Examiner

Psitos

Group Art Unit

2752



☒ Responsive to communication(s) filed on 9/1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

3. Figure 17 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). ✓

Claim Rejections - 35 U.S.C. § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' have submitted three independent claims.

The examiner can not discern any patentable features missing from the independent claims, i.e., all the limitations of claim 1 are found in claims 8 and 13. Similarly, all the limitations of claim 8 are found in claims 1 and 13, and all the limitations of claim 13 are found in claim 1 and 8.

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Hence the examiner cannot readily ascertain the distinction between these independent claims. The dependent claims fail to correct the above deficiency and fall with their respective parent claim.

Additionally, claims 7 & 6 are method claims dependent upon apparatus/product parent claim and hence not a proper product by process. These claims (7 & 6) therefore fail to further limit the product claim. The examiner suggests making the method as the independent claim and have properly written product dependent claims.

Claim Rejections - 35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 U.S.C. § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1,6,7, 8 and 13 are rejected under 35 U.S.C. 102 as being anticipated by the acknowledged prior art.

The product claims read upon applicants' description of the prior art.

The examiner interprets the method limitations as flowing from the product, and hence present in the prior art.

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10. Claims 2, 3, 9, 10, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the acknowledged prior art as applied to claims 1, 8 and 13 above, and further in view of Tsuchiya et al.

The limitations recited (it is noted that claims 9, 10, 11 and 15 duplicate claims 2 and 3 respectively, and hence the examiner will only discuss the limitations of claims 2 and 3 specifically, but the position taken is the same for claims 9, 10, 11 and 15) are found in the secondary reference to Tsuchiya et al - note his values for TP(track pitch), spot size, pit width. Although the groove width is not specifically recited, the examiner takes the position that the groove width in this environment ranges from .4 to .6 micrometers.

The examiner interprets the limitations of these claims to be modifications of the acknowledged prior art in order to maximize/optimize system parameters. Obviously the ability to provide for cross talk prevention is one of those parameters as is increasing recording density.

11. Claims 2-5, 9-12, 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the acknowledged prior art as applied to claims 1, 8 and 13 above, and further in view of Mieda et al.

Again, the limitations of claims 9-12 and 14-17 are found in claims 2-5, and hence the examiner will discuss the limitations of claims 2-5.

Either Mieda et al or Sugaya et al depict optical records having a plurality of pit formats available for maximizing system parameters such as cross talk reduction/ increasing recording density.

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In Mieda et al, figs. 3-5 provide for a variety of parameters to be varied.

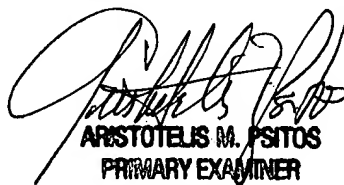
The examiner interprets the "short pit" parameters for meeting the limitations of claims 2 & 3, while the "long pit" parameters for the limitations of claims 4 and 5.

It would have been obvious to one of ordinary skill in the art to modify the acknowledged prior art with the above teachings from Mieda et al -motivation being to maximize system parameters.

Applicants' attention is also drawn to Sugaya et al which also teaches the parameter variations re TP, LP, BD and can be relied upon to meet the limitations of claims 2,3, 9,10,14 and 15.

Applicants' attention is also drawn to Fukuoka et al and Morita for further modifications of record parameters such as TP, LP, NA, GW.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (703) 308-1598.


ARISTOTELIS M. PSITOS
PRIMARY EXAMINER
AU 2752

amp

September 28, 2000